#8 Response 7/8/02

Attorney Docket No. P-582

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

David P. Hornby, et al.

Art Unit No. 1656

Serial No. 09/770,846

Examiner: Campbell, E.A.

Filing date: 01/26/2001

For: **METHOD FOR ISOLATING SINGLE-STRANDED DNA**

RESPONSE

Assistant Commissioner
For Patents
Washington, D.C. 20231

Sir:

This is responsive to the Office Action mailed on 12/19/01.

Claim Rejections under 35 USC 103(a)

Claims 1-27 were rejected under 35 USC 103(a) as being unpatentable over Urdea et al. (Nucleic Acids Res. 16:4937-4956(1988)) and further in view of Boles (US6,300,070).

The independent Claim 1 includes, in step (a), amplifying a target polynucleotide and, in step (b), applying the product of step (a) to a separation medium.

As stated in the MPEP, section 2142, in order to establish prima facie obviousness, the prior art reference must teach or suggest all the claimed limitations. Nowhere does Urdea or Boles show or suggest an amplification followed by application of the amplification product to a separation medium. In

Urdea, amplification takes place while a probe is *bound* to a bead support (FIG. 2). Similarly, in Boles (FIGs 1-3), amplification takes place while a first primer is *bound* to a solid support.

Urdea and Boles lack the combination of the amplification followed by application as indicated in the instant Claim 1. Thus Urdea and Boles separately or in combination do not show or suggest all of the claimed limitations of Claim 1. Applicants respectfully request allowance of Claim 1, and its dependent claims 2-27.

In addition, the Examiner indicated in his rejection of claims 1-27, on page 3, paragraph 2, that "It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine the prior art cited to achieve the claimed invention as a whole." The rejection on this basis is submitted to be contrary to exiting law since the U.S. Court of Appeals for the Federal Circuit held Jan. 18, 2002 that an obviousness determination may not substitute the "common knowledge" of one skilled in the art for specific evidence that the prior art suggests an invalidating combination of references (*In re Lee,* Fed. Cir., No. 00-1158, 1/18/02). Since the Examiner has provided no specific evidence for the rejection under 35 USC 103(a), Applicants respectfully request allowance of Claims 1-27.

As shown above, the application and its claims fully satisfy the requirements of 35 U.S.C. §103(a). Reconsideration and early allowance of the application is respectfully requested.

Respectfully submitted,

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John F. Brady
Registration No. 39,118
Phone: (408) 514-3134
Fax: (408) 432-8910

Transgenomic, Inc.
2032 Concourse Drive
San Jose, CA 95131